# REMARKS

## I. Status and Disposition of the Claims

In the Final Office Action[1] mailed December 11, 2007, the following actions were taken:

1) claims 1, 6-17, 19, 24-35 and 39-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over US Patent Application No. 2005/0021783, by Ishii (hereinafter "*Ishii*") in view of US Patent No, 7,216,368, by Ishiguro (hereinafter "*Ishiguro*");

2) claims 2-5, 18, 20-23 and 36-38 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ishii* in view of *Ishiguro* and further view of US Patent Application Publication No. 2004/0181490, by Gordon (hereinafter "*Gordon*"); and

3) claim 2 has not given patentable weight for the recitation occurring in the preamble.

Claims 1-45 are pending in the application of which claims 1, 19, 33 and 45 are independent. By this amendment, Applicant amends claims 1-3, 5, 6, 9-11, 14-21, 23, 24, 27-29, 32, 33, 35-39, 42, 44 and 45 to further clarify Applicant's invention, and to place the claims in condition suitable for allowance.

Support for these amendments is found in the Specification of the Application, at least page 10, line 15- page 11, line 12, "... Based on the prefix of the URL address of the content file, the invention can determine the URL location of the license. ..., the license can be found through the root directory 'http://www.domain.com/'..." Accordingly, no new matter has been introduced.

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

## II. Response to the Rejections

Applicant respectfully traverses the rejection of the claims under 35 U.S.C. §103(a) because a *prima facie* case of obviousness has not been established. "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) held that "[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, suggestion, motivation] test and the *Graham* analysis." M.P.E.P. §2141 (rev. 6, Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicant understands this to mean that when applicable, as here, TSM reasoning may still be applied not only by an examiner but also by Applicant to refute a §103 rejection.

Here, a *prima facie* case of obviousness has not been established because the scope and content of the prior art has not been properly determined, nor have the differences between the claimed invention and the prior art been properly ascertained. Accordingly, a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art has not been clearly articulated.

**A. The Rejection of Claims 1, 6-17, 19, 24-35 and 39-45 under 35 U.S.C. §103(a) is Improper.**

Claims 1, 6-17, 19, 24-35 and 39-45 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Ishii* in view of *Ishiguro*. *See* Office Action, pages 2-7. In particular, the Office Action contains the assertion, "It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to add the feature of *Ishiguro* to the system of *Ishii* . . . . " See Office Action at 4. Applicant respectfully disagrees and traverses the rejection for at least the reasons stated below.

As discussed in detail below, a fair reading of *Ishii* and *Ishiguro* reveal that the references fail to teach or suggest each and every element of claim 1. In addition, no additional evidence has been raised establishing a tenable rationale that one of ordinary skill would have been motivated to modify the references so as to arrive at the claimed invention.

In the present case, amended independent claim 1 recites, *inter alia*, "using the licensing information address to access the licensing information at the licensing information location," wherein the licensing information comprises licensing information "from which licensed content URL addresses may be identified." *Ishii* does not teach, disclose or suggest this recited feature. The Office Action confirms this. See Office Action at 3.

*Ishiguro* fails to cure the deficiencies of *Ishii*. That is, *Ishiguro* also fails to teach, disclose or suggest "using the licensing information address to access the licensing information at the licensing information location," wherein the licensing information comprises information "from which licensed content URL addresses may be identified," as recited in amended claim 1. The Office Action cites *Ishiguro*'s Figs. 7, 8 and col. 10, lines 24-41 as teaching "using the licensing information address to access the licensing information." See Office Action at 4. However, nowhere in these citations, or elsewhere in *Ishiguro*, is there a suggestion that the licensing information address is used to access the licensing information at the licensing information location.

*Ishiguro*'s Figs. 7, 8 and col. 10, lines 24-41 disclose the structure of *Ishiguro*'s license and *Ishiguro*'s license acquisition process and the structure of the license, in

which a URL is used to access a license server, which requests and obtains license designating information from a client:

> [T]he CPU 21 acquires from the header (FIG. 5) the URL corresponding to the license ID identifying the desired license. [T]he URL denotes the address to be accessed in obtaining the license associated with the license ID also described in the header. In step S62, the CPU 21 accesses the URL obtained in step S61. More specifically, the CPU 21 gains access to the license server 4 through the communication unit 29 and over the Internet 2. At this point, the license server 4 requests the client 1 to input license-designating information for designating the license to be purchased (i.e., license needed for the use of the content), a user ID, and a password (see step S102 in FIG. 9). The CPU 21 displays the request on the display of the output unit 27. Given the display, the user operates the input unit 26 to enter the license-designating information, user ID, and password.

*Ishiguro* at col. 10, lines 24-41. Thus, *Ishiguro*'s URL, corresponding to the license ID as shown in Fig. 7 and referred to in col. 10 at lines 24-41, is not the address of the licensing information itself. "[T]he URL stands for the **address of the license server** 4 from which to acquire licenses." *Ishiguro* at col. 8, lines 49-51. Emphasis added. Moreover, the address of the license server is not the address of the licensing information location. Therefore, *Ishiguro*'s address of the license server will not provide access to the licensing information location, nor will it be used to access licensing information at that licensing information location.

As disclosed above, *Ishiguro* uses the URL to access the license server, which requires additional information from the client to obtain the necessary information for designating the license to be purchased. Thus, access to the license server is not sufficient to access the licensing information. License-designating information from the client is required in addition to the license server address. See *Ishiguro* at col. 10, lines 32-35. Therefore, nowhere in *Ishiguro* at Figs. 7, 8 and col. 10, lines 24-41, or elsewhere in *Ishiguro*, is there a suggestion of using a licensing information address to access the licensing information at a licensing information location. As such, the cited portions of *Ishiguro* cannot teach or suggest, "using the licensing information address to access the licensing information at the licensing information location," recited in amended claim 1.

Further, assuming *arguendo* that *Ishiguro*'s URL may be construed to access licensing information, *Ishiguro* is silent as to whether its licensing information comprises "licensing information from which licensed content URL addresses may be identified," as further recited in Applicant's claim 1.

The Office Action cites Ishii Figs. 7, 9, and 10 to show that "using the address of the license server for receiving the license" has the same functionality as "using the licensing information address to access the licensing information." See Office Action at 3-4. Applicant respectfully disagrees with this assertion. *Ishii*'s Figs. 7, 9 and 10 illustrate a process in which the client acquires the license from the license server. See *Ishii* at para. 0095.

Contrary to Applicant's system, in which the licensing information is accessed at the licensing information location on the server by using the licensing information address, *Ishii* does not disclose using license addresses, let alone accessing the licenses at license locations having license addresses in the server. *Ishii* only accesses the server and the server extracts a list of licenses that are available to be applied to the content that is determined by a user of the client systems. Then, the user selects a desired license from the list provided by the server. Therefore, accessing the license server is not providing access to licensing information using a licensing information address. Further, assuming *arguendo* that *Ishii*'s list of licenses provided by the server may be construed to access licensing information, *Ishii* is also silent as to whether its licenses that are available or its license list comprises "licensing information from which licensed content URL addresses may be identified." As such, using the address of the license server for receiving the license does not have the same functionality as using a licensing information address to access the licensing information.

Because neither *Ishii* nor *Ishiguro* disclose "using the licensing information address to access the licensing information at the licensing information location," in which the licensing information comprises "licensing information from which licensed content URL addresses may be identified," as recited in amended claim 1, the cited references fail to teach or suggest each and every element of claim 1. Moreover, one of ordinary skill in the art would not find it obvious to modify the apparatus of *Ishii,* using the teachings of *Ishiguro* to achieve the required combination recited by claim 1.

Applicant submits that while examiners may rely upon what is generally known in the art, they **must provide evidentiary proof** of that knowledge. *See In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) ("With respect to core factual findings in a determination of patentability . . . the Board cannot simply reach conclusions based on its own understanding or expertise . . . Rather, the Board **must point to some concrete evidence** in the record in support of these findings.") (emphasis is added).

Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would modify the apparatus of *Ishii,* using the teachings of *Ishiguro*, so as to arrive at the claimed invention. In particular, the Office has not explained at least: (a) *why* one of ordinary skill would modify the steps of *Ishii* so as to access a licensing information at a licensing information location using a licensing information address wherein the licensing information comprises licensing information from which licensed content URL addresses may be identified; and, especially, (b) *how* one of ordinary skill would know to select and arrange the steps of *Ishii* and *Ishiguro* (in which URL is used to access a license server, which then requests license-designating information from the client in order to obtain the license designating information) so as to arrive at the claimed feature of "using the licensing information address to access the licensing information at the licensing information location," wherein the licensing information comprises licensing information "from which licensed content URL addresses may be identified," as recited in amended claim 1.

The burden is on the Patent Office to provide some tenable rationale as to *why* and *how* one of ordinary skill in the art would combine *Ishii* and *Ishiguro* so as to arrive at the presently claimed methods recited in claim 1. In the present case, however, no such rationale has been provided.

The Office Action contains an assertion that adding the feature of *Ishiguro* to the system of *Ishii* is "an essential means to [gain] access to the license server through the communication unit and over the Internet." See Office Action at 4. At best, the position taken in the Office Action could be considered an assertion that the proposed modifications could be performed. However, "[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the

art." M.P.E.P. § 2143.01 (emphasis in original). Combining *Ishii* and *Ishiguro* would not result in a predictable variation of Applicant's invention because *Ishii* and *Ishiguro* require external information in addition to a server address to provide access to licensing information. Further, even assuming *arguendo* that the assertion is correct, gaining access to the server is not sufficient for accessing the license since further user input is required. Still further, gaining access to the server is not sufficient for gaining access to licensing information from which licensed content URL addresses may be identified. Therefore, it misses the objective of the Applicant's system, which discloses accessing licensing information from which licensed content URL addresses may be identified by using a licensing information address.

For at least these reasons, Applicant submits that the Office has not met the burdens necessary to establish that present claim 1 is obvious under § 103(a). Therefore the § 103(a) rejection of claim 1 is improper, and should be withdrawn.

For at least the reasons noted above, claims 19, 33 and 45 which recite similar elements and were rejected under the same rationale, and claims 6-17, 24-35 and 39-44 which depend directly or indirectly from claims 1, 19 and 33 are allowable under 35 U.S.C. 103(a). See Office Action at page 9.

## B. The Rejection of Claims 2-5, 18, 20-23 and 36-38 under 35 U.S.C. §103(a) is Improper

Claims 2-5, 18, 20-23 and 36-38 under 35 U.S.C. §103(a) as being unpatentable over *Ishii* in view of *Ishiguro* and further view of *Gordon*. See Office Action at 7. Applicant respectfully disagrees, and traverses the rejection for at least the reasons stated below.

Starting with claim 2[2], Applicant submits that the 103(a) rejection is improper. Claim 2 depends from claim 1, and thus includes all the elements and limitations

[2] The Office Action asserts that the recitation "examining the licensing information to confirming that content is licensed" as specified in claim 2 has not been given patentable weight because the recitation occurs in the preamble. See Office Action at 10. Applicant is unsure of the intent of the comments in the Office Action. In Applicant's view, claim 2 recites elements that specify in more detail elements that are recited in the body of claim 1. Therefore, the elements of claim 2 are not recited in a preamble. If still an issue, Applicant respectfully requests clarification.

thereof. *Ishii* and *Ishiguro* fail to teach, disclose or suggest the features recited in amended claim 1, and required by claim 2, at least "a licensing information address being different from the content URL address," the licensing information address being used "to access the licensing information at the licensing information location." *Gordon* does not cure this deficiency. In particular, *Gordon* does not teach, disclose or suggest using a licensing information address that is different from the content URL address, as required by claim 1. The license and content in *Gordon* are accessed from one unique download URL address of a media file. The URL is used to obtain and play the media content, and once the subscriber clicks on the URL, the license and the media content are delivered to the subscriber's computer. See *Gordon* at para. 0012, 0028 and 0029. Therefore, *Gordon* accesses the license via the content URL and does not use a distinct license address to access the license.

Moreover, one of ordinary skill in the art would not find it obvious to modify a system combining *Ishii* and *Ishiguro,* using the teachings of *Gordon,* to achieve the required combination recited by claim 2.

As noted above, Applicant submits that while examiners may rely upon what is generally known in the art, they **must provide evidentiary proof** of that knowledge. (emphasis is added). Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would combine *Ishii*, *Ishiguro* and *Gordon*.

Here, the Office has not explained *why* or *how* one of ordinary skill would modify a combination apparatus of *Ishii* and *Ishiguro,* in which the licensing information that is input externally prior to allowing access to licensing information which may or may not have URL patterns, using the teachings of *Gordon,* so as to arrive at the claimed invention. In particular, the Office has not explained at least: (a) *why* one of ordinary skill would modify the steps of *Ishii* or *Ishiguro* so as to compare the URL pattern referenced in the licensing information with the content URL address; and, especially, (b) *how* one of ordinary skill would know to select and arrange the steps of *Ishii* or *Ishiguro* or *Gordon* so as to arrive at the claimed feature of "comparing the URL pattern referenced in licensing information with the content URL address," as recited in amended claim 2.

As noted above, the burden is on the Patent Office to provide some tenable rationale as to *why* and *how* one of ordinary skill in the art would combine *Ishii* and *Ishiguro* and *Gordon* so as to arrive at the presently claimed methods recited in claim amended 2. In the present case, however, no such rationale has been provided.

The Office Action contains an assertion that adding the feature of *Gordon* to a *Ishii/Ishiguro* system is "an essential means to increase the speed of transmission licensed contents through securely distribute content system to consumers." See Office Action at 8. At best, the position taken in the Office Action could be considered an assertion that the proposed modifications could be performed. However, "[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01 (emphasis in original). Combining *Gordon* with the system of *Ishii* and *Ishiguro* would not result in a predictable variation of Applicant's system because the *Gordon/Ishii/Ishiguro* system would not use licensing addresses, which are different than the content addresses, to access the license in a separate location than the content without additional external information required. Further, even assuming *arguendo* that the assertion is correct, *Gordon*'s license determining system, in which the licensing information is embedded with the content, would not be applicable to a system like *Ishii* and *Ishiguro*, in which additional information needs to be submitted externally in order to determine whether content is licensed. As discussed above, the license and content in *Gordon* is accessed from one unique download URL address for each unit of content, while *Ishii* and *Ishiguro* require external input in addition to the content URL to access the license since the content and license are not embedded. See *Gordon* at para. 0012. Therefore, one of ordinary skill in the art would not consider combining *Gordon* and *Ishii* and/or *Ishiguro* so as to arrive at Applicant's claims.

For at least these reasons, Applicant submits that the Office has not met the burdens necessary to establish that present claim 2 is obvious under § 103(a). Therefore the § 103(a) rejection of claim 2 is improper, and should be withdrawn. In addition, claims 3-5 and 18, depend directly or indirectly therefrom, are also allowable. See Office Action at 7-9.

For at least the reasons noted above, claims 20 and 36, which recite similar elements and were rejected under the same rationale, and claims 21-23 and 37-38, which depend from claims 20 and 36, are also allowable under 35 U.S.C. 103(a). See Office Action at 7-9.

## III. Conclusion

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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